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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,317	06/08/2001	John J. Sie	19281-001610	9420
20350 7590 03/02/2010 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
BOUTAH, ALINA A				
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2443				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/877,317

Applicant(s)

SIE ET AL.

Examiner

ALINA N. BOUTAH

Art Unit

2443

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 and 19-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 and 19-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CC)
- Paper No(s)/Mail Date 2/22/10
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to Applicant's amendment filed January 19, 2010. Claims 35-38 have been newly added. Claims 9-15 and 19-38 are pending in the present application.

Claim Objections

Claim 35 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 33. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-15 and 19-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Youden (US 5,606,359) in view of Inoue et al. (US 5,729,280).

Regarding claim 9, Youden teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

determining if any of a first segment of each of a plurality of programs sent from the content provider are not already stored (col. 3, lines 53-64 – if data is not already available on one of the disk drive arrays, the archival storage subsystem begins transcribing the video data to the plurality of disks. a predetermined fraction of the video data is stored on each disk sequentially with each disk receiving many small portions of the film. This is also called “data striping.”);

recording any first segment of each of the plurality of programs that are not already stored, wherein determining if any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are performed before any user request for any of the plurality of programs (col. 10, lines 52-54 - “the first five minutes of the two hundred most popular films can be “pre-striped” to one or more disk arrays. A request for one of these films would be serviced quickly with the pre-striped video data, while the remainder of the video data program is recalled from archival storage and transcribed to the disk array”);

detecting the user request for one of the plurality of programs after storing the first segment of each of the plurality of programs (col. 10, lines 36-37 – “a user, through his or her STB makes a request which is transmitted over one of the communication channels in distribution network); and

recording a second segment of the one of the plurality of programs in response to the detecting step (col. 10, lines 62-65 – “once real time controller receives a command to being playing a film, it begins a prefetch to fill the appropriate buffers in data source”).

However, Youden does not explicitly teach recording and storing content at the user location before the user requests the content. In an analogous art, Inoue teaches recording and storing content at the user location before the user requests the content (col. 3, lines 59-63 and col. 8, lines 35-62: prestoring portions of video at the receiver). At the time the invention was made, one of ordinary skill in the art would have been motivated to store content at the user location before the user requests the content in order to allow the user to quickly view the content.

Regarding claim 10, Youden teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of recording any remaining segments of the one of the plurality of programs (col. 10, lines 62-65 – “once real time controller receives a command to being playing a film, it begins a prefetch to fill the appropriate buffers in data source”).

Regarding claim 11, Youden teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment is sent on a first digital channel and the second segment is sent on a

second digital channel (col. 10, lines 52-61 - first segment is pre-stripped while second segment is transcribed from archival storage to disk array).

Regarding claim 13, Youden teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of playing the one of the plurality of programs (col. 4, lines 12-13).

Regarding claim 14, Youden teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the detecting step comprises steps of: receiving a wireless request from a remote control; and processing the wireless request to determine a desired program (col. 4, line 66 to col. 5, line 10 – IR, RF, microwave, etc).

Regarding claim 15, Youden teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (i.e. recording onto user's STB).

Regarding claim 12, Youden fails to explicitly teach the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders. Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders (figures 6A-C; the pre-recorded segments and the remaining of the segments are recorded on different channel). At the time the invention was made, one of ordinary skill in the art would have been motivated to send first and second segments on different transponders in order to allow them to be separately processed, thus ensuring that the viewing of the first segment is faster.

Regarding claim 19, Youden teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording a first segment of a plurality all of the programs sent from the content provider before any user request for the program (col. 10, lines 52-54 - "the first five minutes of the two hundred most popular films can be "pre-stripped" to one or more disk arrays. A request for one of these films would be serviced quickly with the pre-stripped video data, while the remainder of the video data program is recalled from archival storage and transcribed to the disk array");

detecting the user request for selected program of the plurality of programs after recording the first segment of all the plurality of programs (col. 10, lines 36-37 - "a user,

through his or her STB makes a request which is transmitted over one of the communication channels in distribution network).

However, Youden fails to explicitly teach recording a second segment of the selected program if the user request is detected before a stagger period expires wherein the period is less than a duration of the program.

Inoue teaches recording a second segment of the selected program if the user request is detected before a stagger period expires wherein the period is less than a duration of the program (col. 8, lines 35-62: recording the rest of the program; figure 4A – user's request is detected at T6 before a period (of 5 mins) is expired, channel 3 records program a3; col. 8, line 64 to col. 9, line 10).

At the time the invention was made, one of ordinary skill in the art would have been motivated to record a second segment of the selected program if the user request is detected before a stagger period expires in order to ensure that the remaining of the program is recorded, thus allowing viewer to view the entire content.

Youden also does not explicitly teach storing content at the user location before the user requests the content. In an analogous art, Inoue teaches storing content at the user location before the user requests the content (col. 3, lines 59-63 and col. 8, lines 35-62: prestoring portions of video at the receiver). At the time the invention was made, one of ordinary skill in the art would have been motivated to store content at the user location before the user requests the content in order to allow the user to quickly view the content.

Regarding claim 20, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the detecting step comprises a step of detecting the user request for the program during the step of recording the first segment (col. 8, lines 35-62).

Regarding claim 21, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the recording steps comprise a step of recording on a rotating disk at the user location (col. 4, lines 36-46).

Regarding claims 22 and 25, Inoue teaches wherein the first segment of each of the plurality of programs is sent from the content provider once (figure 4A).

Regarding claims 23 and 26, Inoue teaches wherein the first segment of each of the plurality of programs are sent from the content provider on the same channel (figure 4A).

Regarding claims 24 and 27, Inoue teaches wherein the second segment of the selected program is sent from the content provider more than once and on more than one channel (figure 4A).

Regarding claims 28 and 29, Inoue teaches wherein the second channel does not send the first segment and the first digital channel does not send the second segment (figure 2A – i.e. each of the segments are being sent from different channels).

Regarding claim 30, Inoue teaches wherein the first segment is sent only once (figure 2A).

Regarding claim 31, Inoue teaches wherein the first segment is sent via a first delivery mechanism and the second segment is sent via a second delivery mechanism (i.e. broadcast system such as cable).

Regarding claim 32, Inoue teaches wherein first delivery mechanism comprises a cable television network. However, Inoue does not explicitly teach the second delivery mechanism comprising a broadband network connection. Nevertheless, one of ordinary skill in the art would recognize that is obvious since broadband is known to be one of

many mechanisms that deliver videos. One of ordinary skill in the art would have been motivated to employ broadband because it is cheap, fast and reliable.

Regarding claims 33, 35 and 37, Inoue teaches the method of claim 9, wherein the user location comprises a residence of the user (col. 8, lines 35-46 – user's location).

Regarding claim 34, Inoue teaches the method of claim 29, further comprising determining the stagger period at the user location based on a linear schedule indicating a start time for the second segment on the second digital channel (figures 4A and 4B).

Regarding claims 36 and 38, Youden teaches the method of claim 35, wherein the user location further comprises a Set Top Box (STB) at the residence of the user (col. 3, lines 43-45).

Response to Arguments

Applicant's arguments with respect to claims 9-15, 22-24 and 28-33 have been fully considered but they are not persuasive. Youden and Inoue combined teach the claimed invention. As presented above, Youden teaches recording any first segment of

each of the plurality of programs that are not already stored while Inoue teaches recording the segments at the user's location before the user requests a program. Inoue, col. 8, lines 47-51, for example states that "pre-storage of the first segment of a video program may be accomplished by a variety of different methods. For example, the microcomputer may **automatically** initiate recording of the program segment from a broadcast signal at a predetermined time." Automatically recording clearly implies that it is being recorded without being requested by user. Therefore, Youden in view of Inoue teaches the claims as amended.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALINA N. BOUTAH whose telephone number is (571)272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia L.M. Dollinger can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alina N Boutah/
Primary Examiner, Art Unit 2443